

## II. **Remarks**

By this paper, Applicant is amending claims 1, 10 (withdrawn), 13, 19, 23 (withdrawn) and 32-36 (withdrawn). Therefore, after entering this amendment, claims 1, 3-6, 9, 19, 22, 29, and 30 are currently pending.

No new matter is added by any amendment herein. Reconsideration and further examination of this application in view of the above amendments and the following remarks is therefore respectfully requested.

### ***Claim Rejections – 35 U.S.C. § 102***

Citing 35 U.S.C. § 102(b) the Office Action rejected claims 1, 3-5, 19, and 29-30 as being anticipated by Morrison (US4748986), and claims 31-34 as being anticipated by deToledo (US5178158).

Each of the independent claims has been amended to clarify that the claimed device includes an open lumen that is unoccupied for substantially its entire length. As the Examiner stated that the partially-open space around the core element of Morrison was the basis for retaining the rejections in view of Morrison, and dropped the previously cited Miyata and Tezuka references, Applicant understands that this clarification of the structure will overcome the pending rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (from MPEP § 2131). Morrison fails to disclose wire coils wound adjacent to one another defining an open lumen that is unoccupied for substantially its entire length. Specifically, the wound wire shaft of Morrison is not open and unoccupied for substantially its entire length in that it requires an elongate core element (e.g., elongate elements 12, 32, which – although they may be cylindrical, nonetheless occlude/occupy the space around which coils 13, 33 are formed without leaving an open lumen such as is disclosed in the present application at, for example, ¶¶[0018], [00418], [0050], [0073], and FIGS. 2, 3, 8, and 28-32). Therefore, none of claims 1, 3-5, 19, and 29-30 are anticipated by Morrison. Claim 31 is canceled herewith, and its

limitations are included into claim 36, which is withdrawn, together with its dependent claims, all of which include a dilatation balloon not disclosed by deToledo.

Because none of these claims is anticipated, the art of record lacking at least one claimed element for each pending claim, Applicant respectfully requests that the rejections be withdrawn and the claims recognized as being in condition for allowance.

***Claim Rejections – 35 U.S.C. § 103***

Citing 35 U.S.C. § 103(a) the Office Action rejected claims 1, 4, 5, 9, 19, and 22 and as being obvious over deToledo in view of Mortier (US5961511), and claim 6 as being obvious over Morrison in view of Jafari (US5980471).

The office action has not established a prima facie case of obviousness in view of these references. As correctly acknowledged in the office action, deToledo does not disclose a taper portion. However, one of skill in the art would not have any motivation from Mortier to provide a taper feature to the wound wire construction of deToledo as is alleged in the office action. First, Mortier establishes its taper by removing an intermediate lining layer for a tapering portion of its length rather than establishing a taper portion as presently claimed within a lumen that is defined as open and fully unoccupied (which precludes the stiffening material in Mortier's lumen). Second, Mortier is constructed using a braid, rather than a wound wire construction as is presently claimed such that the structural dynamics required to effect a tapering are accomplished in a very different manner as compared between Mortier and the present claims. In addition, the office action incorrectly alleges that creating a tapered portion would automatically result in the tapered portion of wire coils being wound at a different pitch angle than wire coils in another body portion. Although pitch angle may be used in conjunction with tapering and vice versa, neither automatically necessitates the other.

Each of the independent claims is distinguished from the art of record. Therefore, each of the pending dependent claims are allowable for at least the reasons discussed above. Accordingly, Applicant respectfully requests that the rejection be withdrawn and these claims recognized as being in condition for allowance (including rejoinder of the withdrawn claims, which include all of the same limitations).

**Conclusion**

In view of the above amendments and remarks, it is respectfully submitted that the present claims are patentably distinguishable over the art of record and that this application is now in condition for allowance, including that Applicant requests rejoinder of the withdrawn claims. The Examiner is invited to contact the undersigned attorney for the Applicant via telephone number (312) 222-8104, if such communication would expedite this application.

Respectfully submitted,

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